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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/976,573	10/12/2001	Jacob Thomas	970236 U1C1P1 USA	2700

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EXAMINER
MCELHENY JR, DONALD E

ART UNIT	PAPER NUMBER
2862	

DATE MAILED: 02/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/976,573	Applicant(s) THOMAS ET AL.	
	Examiner Donald E. McElheny, Jr.	Art Unit 2862	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-36* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-36* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *12 October 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *4* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

1. 35 U.S.C. 101 reads as follows:

> **Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.**

2. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

3. Claims 1-36 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-34 of prior U.S. Patent No. 6,356,844. This is a double patenting rejection.

Independent claim 1 of the instant application corresponds with independent claim 1 of the patent '844 and independent claim 25 of the instant application corresponds with independent claim 23 of the patent. The only difference being that the concept and claim feature of "production/injection" of the well/reservoir is sometimes referenced within the application and patent claims alternatively as just "production" at some points within the same claim. The antecedent basis within the claim is identical, as well as the basis within the written disclosure of the application and patent. Also, one skilled in the art would have known that "production" and "production/injection" are synonymous and the concept of flow rate dictates the well fluids and reservoir fluids are either being pumped out, turned off and static, or being pumped in and thus the same

identical inventive concept. The dependent claims are either identical in correspondence or the two new claims the same inventive concepts previously claimed but with different dependency order and thus the same invention combination concepts already patented.

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-36 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-32 of U.S. Patent No. 6,266,619. Although the conflicting claims are not identical in wording, they are not patentably distinct from each other because the subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent and differ in some claims only in the semantics of language used to claim identical features or differ at most in other claims by minor differences of obvious type nature, as follows:

Independent claim 1 of the instant application corresponds with independent claim 1 of the '619 patent. The only difference being the change of the patent claim's terms/phrases "field wide reservoir data" to just "reservoir data", and "opening or closing

the well control device in response to the signal to increase or decrease the production of one or more selected wells" to "adjusting the well control device control device in response to the signal to increase or decrease the production/injection of the one or more selected production zones". When one views the basis in the specifications of both the patent and application for the meanings of these terms/phrases they are identical in basis and interpretation and therefore either straight statutory double patenting or of non-statutory obvious type differences. The patent's claim 1 begins the reference to the reference to reservoir data purpose for "production/injection forecast", then only references the flow control by "the production of". The application's claim 1 change to continue to reference flow control for "production/injection" is the same inventive concept because both the injection of fluid or withdrawal of fluid are inherently indeed the act of production of the reservoir. Also, likewise "selected wells" and "selected production zones" find the same supportive basis and are understood by those of ordinary skill in the art to be the same and only a difference in the artful use of language to describe such reservoir production concept; one 'produces' by drilled 'wells' in the reservoir field; one 'controls' the reservoir by injection and withdrawal of fluids therefrom. Likewise the control of the fluid from the wells/production zones/reservoir is by controlling/"adjusting" the wells, or alternative phrasing and inherent adjusting of the well control devices "opening or closing" their valves. Thus these claimed features are identical in basis and scope. If any other interpretation of these claimed features is intended by applicants then such must be clearly established within the claims and arguments of record; and even still such differences would amount to merely obvious

type differences of unpatentable difference that one of ordinary skill in the art would have routinely considered in their implementation of reservoir production control, if not just outright arbitrary choice of claim drafting language.

Likewise claim 25 of the '619 patent corresponds with claim 20 of the instant application, and differ only in the artful use of language to describe identical claim features. The change from "CPU for processing" in the patent to "a processor for processing" are identical in support in the written specifications as well as their functions of their means-plus-function statements in the claims. Other possible differences are those already covered above for discussion of claim 1.

Dependent claims from the above discussed claims are either identical or of similar differences in language that are not patentable differences for similar reasoning as set forth above.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See also MPEP § 804.

6. Claims 1-36 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-32 of prior U.S. Patent No. 6,266,619. This is a double patenting rejection. See the reasoning in above discussion of obvious-type double patenting for this same patent. Since the claimed inventive features can be so argued as being identical in basis and intended coverage they therefore would fall under straight double patenting of the same invention once again in the instant application.

7. Any consideration of possible newly cited prior art other than that of record in the patents already granted would be a matter of nature for reexamination or reissue type application proceedings of the patents.

8. This is a C-I-P application of applicant's earlier Application No. 09/816,44, which is a continuation of Application No. 09/357,426. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald McElheny Jr., whose telephone number is (703) 305-3894.

Fax transmissions may be directed to (703) 308-7724.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0956.

If attempts to reach the Examiner are unsuccessful, the Examiner's supervisor, Edward Lefkowitz, can be reached at (703) 305-4816.

DONALD E. McELHENY, JR.
PRIMARY EXAMINER